

### **III. REMARKS**

#### **Status of the Claims**

Claims 5, 11 and 15 are amended. Claims 1-15 and 19-22 remain under consideration.

Claims 5 and 11 are amended to conform to the Examiner's statement of allowable subject matter. No new subject matter is claimed and further searching should not be needed. Applicant submits that such amendments are properly entered under 37USC1.116 and accordingly, Examiner is requested to enter these amendments.

#### **The Office Action and Responsive Remarks**

Independent Claim 15 is amended for clarification. No new matter is presented. The amendments to the claim are not intended to be limiting, are not made for reasons related to patentability, and should not be interpreted to raise issues of estoppel. It is noted that Claims 5 and 11 are indicated to contain patentable subject matter, if written in independent form and applicant has amended these claims accordingly.

Applicant has considered the Examiner's comments set forth in the Final Office Action mailed October 2, 2006. Reconsideration of the application is respectfully requested.

#### **The Office Action**

Claims 1,2,9,15,20, and 22, stand rejected under 35USC102(e) on the basis of the cited reference Taylor, U.S. Publication No.20030025679. The Examiner is respectfully requested to reconsider the rejection in view of the above amendments and the following remarks. This rejection is traversed on the following grounds:

The cited reference Taylor fails to disclose each and every limitation of the claims of this application. It is well settled that a claim is anticipated, "only if each and every

element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See CHISOLM, Federal Circuit Guide, Pg. 1221). In particular claim 1 states:

**"a keyboard plate fixed over the touch sensitive element so that the depression of a key of the keyboard plate causes said key to touch the touch sensitive element essentially at a position on the touch sensitive element corresponding to the point of the key and means for correlating the position of touching on the touch sensitive element, according to which key is depressed."**

Taylor fails to disclose these features.

The reference Taylor provides **two independent** means by which data may be entered, namely, keymat 22 with keys 20, and touchpad 26. This is explained in paragraph 0037 of Taylor as follows:

**"Keypad posts associated with each key pass through an electrode grid of the touchpad in such a way so that the posts do not interfere with touchpad detection and tracking of a pointing object that moves along the keypad surface. The keys of the keypad provide the first type of user input. The touchpad is capable of providing data entry, cursor control, and scroll bar control on a display of the mobile telephone. Thus, the touchpad provides the second type of user input. The keys of keypad provide discrete input in the form of alphanumerical characters. In contrast, the touchpad is an impedance sensing means. More specifically, the touchpad utilizes mutual capacitance-sensing technology to determine the location of a finger over a surface thereof."**

There can be no doubt from this language, considered with figures 2 and 3 of Taylor, that actuation of the keys of Taylor does not cause the keys to touch the touchpad 26. In Taylor the keys push past 24 through aperture 28 to actuate a mechanical switch 32 on substrate 30 underneath the touchpad 26. Note the description in Taylor at paragraph 0040 as follows:

**"The key 20 includes a post 24 that is utilized to actuate a mechanical switch 32 when the key is pressed."**

Paragraph 0044 states that the "apertures 28 are disposed through the touchpad 26 to enable passage of the posts 24".

The relationship of the touchpad and keymat is clearly independent and is constructed to avoid interference in the operation of the two means of input. This is clear from the description in paragraph 0048 of Taylor as follows:

**"FIG. 3 is a close-up profile cross-sectional view of a portion of the keypad 18, wherein the key 20 having post 24 is disposed over aperture 28 through the touchpad 26. The post 24 is adjacent to or even resting on the dome 36. The switch substrate 30 is shown spaced apart some distance by gap 40 to enable the dome 36 to be actuated by the post 24."**

Clearly aperture 28 is aligned with key post 24 so that the post passes through the touch pad 26. It does not touch the touch pad as is claimed by Applicant. This is clear from the above language of paragraph 0037 repeated below for emphasis:

**"Keypad posts associated with each key pass through an electrode grid of the touchpad in such a way so that the posts do not interfere with touchpad detection and tracking...."**

The cited reference Taylor fails to disclose a keypad, the keys of which touch a touch element in a manner that corresponds to the claims of this application.

The Examiner relies on an excerpt from the reference Taylor that indicates that deformation of the touchpad of Taylor should be minimized to reduce damage. Taylor therefore teaches that touching of the touchpad 26 by key post 24 is to be avoided. It therefore cannot be used by the Examiner as a disclosure of the exact opposite, namely, that the keys are used to touch the touch sensitive element. Further Taylor teaches away from interfering with the electrode grid of the touchpad. Therefore, there can be no establishment of a position indication of the key post 24 on the touchpad 26. This is a required element of the claims of this application.

Taylor also does not disclose or suggest means for correlating the position of touching on the touch sensitive element according to which key is depressed as recited by Applicant in the claims.

As noted above, in Taylor, the key/keymat is not configured to touch the touchpad. Rather, Taylor relies on post 24, which passes "through" the touchpad, to contact the switch. Figures 1-3 of Taylor clearly demonstrate that the keys do not "touch" the touchpad in a manner as claimed by Applicant. While the touchpad may be close to the keymat 22 and key 20, it is the "aperture 28" that makes operable the configuration of the keypad 18. Thus, the keys in Taylor do not touch the touch sensitive element and therefore Taylor cannot disclose or suggest means for correlating the position of touching on the touch sensitive element as claimed by Applicant.

For all of these reasons, the disclosure of Taylor, therefore, does not support the rejection based on anticipation.

Claims 4,10 and 19 stand rejected under 35USC103(a) on the basis of the cited reference Taylor in view of the reference Lee, U.S. Patent No. 6,243,595. In addition, Claims 3,6-8,12, and 21 stand rejected under 35USC103(a) on the basis of the cited reference Taylor in view of the reference Riddiford, U.S. Patent No. 6,587,675. The Examiner is respectfully requested to reconsider his rejections in view of the following remarks. These rejections are traversed on the following grounds:

The combined teachings of Taylor and Lee and Taylor and Ridderford do not render the respective claims obvious because they fail to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a *prima facie* case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) ***In re***

09/716,880  
Response to the Office Action mailed October 2, 2006

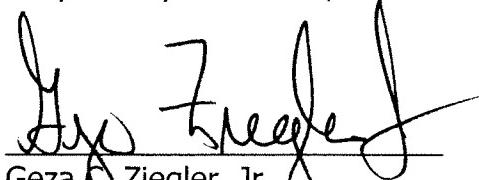
***Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."***

In particular the combined teaching fails to disclose or suggest the claimed features of independent claims 1,9 and 15 as indicated above. These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims. None of the cited references remedy the deficiencies of the primary reference Taylor.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for the one month extension of time (\$120) as well as any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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2 Feb 2007

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Lisa Shimizu

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